

Remarks

In view of the above amendments and the following remarks, reconsideration and further examination are respectfully requested.

Claims 1-49 were previously canceled, and claims 77-80 have been added in the present response. Also, in the present response, claims 50, 51, 65, 70 and 75 have been amended. Consequently, claims 50-80 are currently pending and under consideration. It is submitted that the claims as amended are supported by the originally filed patent application.

In item 4 of the Office Action, dependent claim 75 was indicated as containing allowable subject matter if rewritten into independent form. In the present response, claim 75 has been rewritten into independent form, so it is believed that claim 75 is in condition for allowance.

It is believed that independent claim 50, as presently amended, is allowable over the references of record. For instance, the cited references fail to disclose or suggest "deleting the second message from the email server in response to said determining; retrieving a third message from the email server that is different from the first message, wherein the third message includes an email that has the common trait with the first message; recognizing with the unified messaging system that the third message has the common trait with the first message; and deleting the third message from the email server in response to said recognizing" as recited in claim 50 (emphasis added).

In particular, it should be recognized that U.S. Patent No. 5,647,002 to Brunson does not disclose the above-mentioned features. Brunson generally concerns a method for synchronizing email 29 and voicemail 39 systems. Synchronizer 10 creates a copy of the same message in both the email system 29 and the voicemail system 39 as well as maintains a mailbox-pair state table 200 for tracking each message pair. When a copy of one of the messages from the pair is deleted in one mailbox, the other copy of the same message is deleted from the other mailbox.

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However, it should be recognized that the synchronizer 10 in Brunson is not configured to delete messages that are different from one another and yet share a common trait. Moreover, the synchronizer in Brunson only handles message pairs, that is, only a single email message is deleted from the email server 20 when the same message is deleted from the voicemail server 30. The synchronizer 10 in Brunson does not delete two or more messages from the same email server, and specifically, Brunson fails to describe deleting second and third messages from the email server that have a common trait with the first message, as is recited in claim 50. Thus, for this and other reasons, Brunson fails to anticipate claim 50 and its dependent claims.

Likewise, it should be appreciated that U.S. Patent No. 6,373,926 to Foladare et al. fails to disclose the above-mentioned features. Foladare generally concerns a centralized messaging service that sends a copy of the same message messaging services that are designated by a receiving party. When the party retrieves the message from one of the services, the centralized messaging service deletes the message from the other services. Like Brunson, the system in Foladare merely deletes the same message across different platforms, and does not delete from the same email server two or more different messages sharing a common trait with a first message. Since Foladare fails to disclose all of the features recited in claim 50, Foladare does not anticipate independent claim 50.

In item 3 of the Office Action, claim 50 was "rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neal et al. 6,640,242 in view of Tatchell et al. US 5,905,774 and further in view of[,] Tzirkel-Hancock US 5,960,395." In order to establish a *prima facie* case of obviousness, the Patent Office has the initial burden of identifying in the prior art some teaching, suggestion or motivation to modify the cited references. In order to meet this initial burden, three basic criteria must be met.

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when

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combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." MPEP §2142 (citing, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). The suggestion/motivation to combine or modify under §103 needs to be specific. Where a "statement is of a type that gives only general guidance and is not specific as to the particular form of the claimed invention and how to achieve it ... [s]uch a suggestion may make an approach 'obvious to try' but it does not make the invention obvious." Ex parte Obukowicz, 27 USPQ2d 1063, 1065 (B.P.A.I. 1993) (citations omitted). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'" In re Fritch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing, In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

The references cited in Item 3 of the Office Action fail to explicitly or implicitly provide any teaching, suggest or motivation to arrive at the invention recited in claim 50. Even when combined together, these references further fail to disclose all of the features recited in claim 50. As discussed in the previous amendments as well as at the previous interview, the technique recited in claim 50 allows multiple messages sharing a common trait to be deleted from an email server without the need to play all of the messages on the telephone. Page 14 of the present application notes that this technique simplifies the interface between the unified messaging system and the email server so that the ability to delete messages does not depend on the capabilities of the email server.

In the Office Action, it appears that impermissible hindsight was used to arrive at the combination of features recited in claim 50 because the motivation provided to combine the references was not specific enough to arrive at the features recited in

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claim 50. Initially, it should be recognized that none of the references explicitly provide the motivation alleged in the Office Action. Rather, the purported motivation in the Office Action in essence implies that the three references "all teach using voice commands for managing messages through the telephone . . . so that a single voice command would have been able to manage multiple voicemail or e-mail messages." However, this hindsight-derived motivation fails to provide any incentive to arrive at the features recited in detail in claim 50. The use of voice commands in itself would not logically necessitate (or provide motivation for) the deletion of multiple messages on email servers in the recited manner. It was admitted in the Office Action that "O'Neal fails to teach deleting multiple messages." Both Tzirkel-Hancock and Tatchell each only briefly mention the deletion of messages from voicemail systems in a single sentence, and both fail to describe how their systems actually delete the messages. Moreover, neither reference even discusses deleting multiple messages from an email server. For instance, Tzirkel-Hancock at column 41, lines 39-40 only mentions that "once a local user has replayed all new messages from the user David, he may input the speech command 'Delete old messages from David'" (emphasis added). This is contrary to the recited technique that allows messages to be deleted without having the messages played. Even assuming for argument's sake that these references were able to be combined together, they would still fail to motivate one of ordinary skill in the art to perform the particular above-discussed steps that simplify the interface between a unified messaging system and an email server. It is quite conceivable, and probably likely, that after reading the cited references, especially Tzirkel-Hancock, one skilled in the art would have been motivated to use a batch type process in which the messages are only deleted only after the messages are played, which is contrary to the recited technique. For this as well as other reasons, it is submitted that claim 50 and its dependent claims are allowable over the references of record.

As should be appreciated from the previous discussion, independent claim 65 is also allowable over the references of record. For instance, the cited references fail

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to disclose or suggest "determining with the unified messaging system that an email message on the email server has the trait in common with the first message, wherein the email message has content that differs from the first message; and deleting the email message from the email server in response to said determining without transmitting the email message to the telephone" as recited in claim 65. As mentioned before, Brunson and Foladare both teach deleting the same message from a voicemail server and an email server, and not messages that differ in content. Moreover, the only way to arrive at the features recited in claim 65 would be through impermissible hindsight. Thus, for these and other reasons, it is submitted that claim 65 and its dependent claims are in condition for allowance.

It is further believed that independent claim 70 is allowable over the references of record. By way of example, the cited references fail to disclose or suggest "the unified messaging system being operable to delete an email message from the email server in response to determining that the email message has the common trait in common with the first message, wherein the email message and the first message were received at different times." Brunson and Foladare both teach deleting the same message from a voicemail server and an email server, and not messages that were received at different times. Further, claim 70 would not be rendered obvious by the references of record because the only way to arrive at the recited apparatus would be through impermissible hindsight. Therefore, it is believed that independent claim 70 and its dependent claims are allowable over the references of record.

In addition to the reasons given above as to the allowability of the independent claims, additional reasons support allowance of the dependent claims. For example, none of the references disclose or suggest "receiving a second command from the telephone instructing the unified messaging system to delete only the fourth message; and deleting only the fourth message" as recited in dependent claim 77. None of the references disclose unified messaging systems that are capable of deleting multiple email messages sharing a common trait and at the same time are further capable of deleting a single email message in response to a command.

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It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the rejections in the Office Action, but are simply provided to overcome the rejections made in the Office Action in the most expedient fashion.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance, and the Examiner is requested to pass the case to issue. If the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact the applicants' undersigned representative.

Respectfully Submitted,

By 

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